

REMARKS

New Claims

The new claims are similar in scope to the previously pending claims, which have been cancelled and represented for convenience in further prosecution. Some of the claims contain minor amendments which are not believed to alter the scope of the claims, or which broaden the claims.

Election/Restrictions

Claims 77-81 drawn to a non-elected invention have been cancelled.

Oath/Declaration

A supplemental oath or declaration in compliance with 37 C.F.R. 1.67(a) will be submitted as required. The original oath or declaration was defective due to a typographical error in spelling of the applicant's first name.

Information Disclosure Statement

The examiner states that the information disclosure statement filed October 31, 2002, fails to comply with 37 CFR 1.97(c). Specifically, the examiner states that the IDS fails to provide an abstract date of Reference BK (WO 00/09856). The above-described IDS was filed in compliance with the office action dated July 3, 2002, wherein the examiner requested the reference to be cited under "Other Disclosures." Applicant submits an amended Information Disclosure Statement, as recommended by the examiner.

Claim Objections

The examiner objected to claims 3, 25, 42, 60, 93, 95, 104, 127-128 and 131 under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter

of a previous claim. All of the pending claims have been cancelled and new claims added. The new claims are believed to overcome the objections and to be in condition for allowance.

Double Patenting

The examiner objected to claims 1, 3-9, 11-13, 15-16, 18-76 and 82-143 under 37 C.F.R. §1.75 as containing numerous occurrences of substantial duplicate claims. Applicants submit that the new claims do not include "substantial duplicate claims," and are in condition for allowance.

35 U.S.C. §112, second paragraph

The examiner rejected claims 1, 3-9, 11-13, 15-16, 18-76 and 82-143 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The new claims are believed to overcome the rejections and to be in condition for allowance.

Rejections Under 35 U.S.C. § 103

-Rejection of claims over Juprasert v. McCUTCHEON's and Mokadam and Gardner

The examiner rejected claims 1, 3-9, 11-13, 15-16, 18-62, 65-81 and 92 -143 under 35 U.S.C. §103(a) as being unpatentable over Juprasert et al., in view of McCUTCHEON's VOLUME 1; Mokadam (US 5,797,456); and Gardner et al. (US 5,008,026).

Response

The examiner commented that not all of the pending claims include the limitation to:

- a second solubilizing quantity of a mutual organic solvent selected from the group consisting of water soluble glycol ethers, water soluble amides, water soluble ketones, and water soluble alcohols selected from the group consisting of methanol, ethanol, 1-propanol, and 2-propanol, said mutual organic solvent being effective to solubilize said demulsifier and said non-ionic surfactant to produce said demulsifier composition.

All of the new claims include this limitation, or a narrower limitation.

The examiner admits that "Juprasert et al differs from the claims in an explicit disclosure of the claimed demulsifiers, the particular combinations of agents and the concentrations set forth in the dependent claims." Each of the new claims are believed to comprise the claimed features which the examiner admits are not taught or suggested in the cited references. For all of the reasons given in the previous office action, the examiner has not established a case of *prima facie* obviousness of the claimed combinations.

The examiner cannot establish *prima facie* obviousness merely by arguing that the claimed combination(s) could be derived by modifying one cited reference to incorporate something not taught or suggested by the reference, itself, or by another cited reference. In order to establish *prima facie* obviousness, the examiner has the burden to point to a teaching or suggestion in the **references themselves** that it would be desirable to make such a modification. MPEP 2143.01; *In re Brouwer*, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1995).

The examiner has not pointed to a teaching or suggestion that would motivate a person of ordinary skill in the art to modify any of the cited references in the manner required to result in the combination(s) specifically required by the claims.

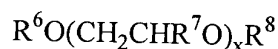
Applicant submits that the examiner is required to examine each claim individually, and to allow at least those claims that the examiner considers to be patentable. The claims have a

variety of claim scopes. For example, relatively narrow claim 63 (now pending as claim 168), reads:

168. A demulsifier composition to prevent or resolve downhole emulsions in aqueous solutions, said demulsifier composition comprising:

a demulsifying amount of a 2-propanamine salt of dodecyl benzene sulfonic acid effective to perform a function selected from the group consisting of demulsifying an emulsion in an aqueous solution and preventing formation of an emulsion in an aqueous solution;

a first solubilizing quantity of an alcohol ethoxylate having the following general formula



wherein

R^6 is an alkyl group having from about 8 to about 16 carbon atoms;

R^7 independently is selected from the group consisting of hydrogen and alkyl groups having from about 1 to about 6 carbon atoms;

R^8 is selected from the group consisting of hydrogen and alkyl groups having from about 1 to about 6 carbon atoms;

x is from about 2 to about 20; and

a second solubilizing quantity of a mutual organic solvent selected from the group consisting of ethylene glycol monobutyl ether (EGMBE) and ethylene glycol monomethyl ether (EGMME).

The examiner cannot reasonably contend that he has established a *prima facie* case of obviousness of claim 168 and dependent claims. The examiner should indicate which of the pending claims represent allowable subject matter, even if the examiner does not agree that all of the pending claims are allowable.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the rejections be withdrawn and that all of the pending claims be allowed. The commissioner is hereby authorized

to charge any unpaid fees or to credit any overpayment of fees in connection with this paper to
Deposit Account No. 02-0429, maintained by Baker Hughes Incorporated.

Respectfully submitted,



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